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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,270	11/14/2003	Fridolin Babler	CO/2-22801/P1/CGC 2134	2019
324	7590	10/04/2004	EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION			GREEN, ANTHONY J	
PATENT DEPARTMENT			ART UNIT	
540 WHITE PLAINS RD			PAPER NUMBER	
P O BOX 2005			1755	
TARRYTOWN, NY 10591-9005			DATE MAILED: 10/04/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/714,270	Applicant(s) BABLER, FRIDOLIN	
	Examiner Anthony J. Green	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-16 is/are allowed.
- 6) ☒ Claim(s) 1-10, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 19-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/19/04&amp;08/02/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: There is no Brief Description of the Drawings found in the specification.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4-6, 10, and 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is confusing as it contains improper Markush terminology.

In claim 10, the phrase "obtainable by" is not a positive claim limitation.

In claim 17 the use of the term "preferably" renders the claim vague and indefinite because it is unclear whether the limitations following the term are part of the claimed invention and the scope of the claim is unascertainable. See MPEP § 2173.05(d).

In claim 18, the phrase "obtainable by" is not a positive claim limitation.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al (US Patent No. 6,143,807).

The reference teaches, in the claims and the claims, pigment ink jet ink compositions comprising a pigment wherein at least 50% of the pigment particles have an average diameter or size  $\leq 0.3$  microns with the remaining particles in the ink composition having a diameter or size of  $\leq 0.3$  microns, water, a dispersant which is the reaction product of an aldehyde and a naphthalene sulfonate salt.

The instant claims are obvious over the reference. The reference suggests the use of pigments having a particle size encompassed by that which is instantly claimed. Applicant's attention is drawn to example 1, wherein the reference teaches that the majority of the pigment particles (i.e. greater than 50%) are less than 0.1 microns (i.e. 100 nm). Accordingly the limitation of the particle size of the pigment is met by this example of the reference. As for the type of pigment, since the pigment is carbon black having a polyaromatic content it can be considered to be an organic pigment per se. See also column 9, lines 1+, which recite various types of pigments useable, some of which are organic in nature which would render obvious instant claims 3-6. As for the molecular weight of the naphthalene sulfonate formaldehyde polymer (recited in claim 1

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and 2) while this is not taught by the reference, applicant has not shown that the use of a polymer having this molecular weight produces results that are not expected.

Accordingly it would have been obvious to use a polymer having any molecular weight in the composition of the reference since no specific molecular weight is taught or suggested by the reference. The same holds true for instant claims 7-9, since the reference does not specify a particular polymer it would have been obvious to use any naphthalene sulfonate formaldehyde polymer absent evidence showing otherwise as the type of polymer utilized in the reference does not appear to produce unexpected results. Accordingly based on the above reasoning, the instant claims are deemed obvious over the reference.

***Allowable Subject Matter***

6. Claims 11-16 are allowable over the art of record, as the prior art fails to teach and/or fairly suggest the instant process.

7. Claims 10 and 17-18 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. Claims 19-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Information Disclosure Statement***

9. The references have been considered however they are not seen to teach and/or fairly suggest the instant invention.

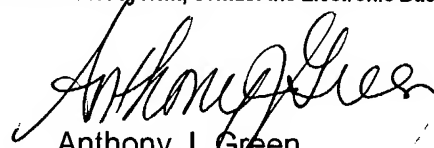
***References Cited By The Examiner***

10. The remaining references are cited as showing the general state of the art and as such, they are not seen to teach or fairly suggest the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anthony J. Green  
Primary Examiner  
Art Unit 1755

ajg  
September 29, 2004